SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

October Term, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

Petitioners pray that a writ of certiorari issue to review the decision of the United States Court of Appeals for the District of Columbia, rendered in the above entitled case on July 21, 1967.

Citations to Opinion Below

The decision of the Court of Appeals for the District of Columbia is reported at 154 U. S. P. Q. 464 and is printed for convenience in Appendix B hereto, page 30. The decision of the District Court for the District of Columbia is unreported and is printed in Appendix B hereto, page 34. The decision of the Commissioner of Patents, constituting

the agency action judicial review of which is requested, is unreported and is printed in Appendix B hereto, page 35.

Jurisdiction

The decision of the Court of Appeals for the District of Columbia was rendered on July 21, 1967 (App. B, page 30). No petition for rehearing has been filed. The jurisdiction of this court is invoked under 28 U. S. C. 1254 (1).

Questions Presented

1. Whether decisions of the Commissioner of Patents or his delegate in response to a properly framed petition, invoking the jurisdiction of the Commissioner under his own rules are to be exempted from judicial review by the Federal Courts in the absence of any statute so specifying, even though such decisions are final and not otherwise reviewable.

2. Whether foreign applicants for United States patents are to be denied judicial review of an otherwise unreviewable act of an Administrative Agency, i.e., the Patent Office as represented by the Commissioner of Patents, when the jurisdiction of the Federal Court has been invoked under 28 U. S. C. 1361 singly or in conjunction with 5 U. S. C. 1009.

3. Whether federal judicial review of an administrative decision should be denied on the sole ground that different issues could still be litigated in a quasi-judicial proceeding all of which different issues would be rendered moot by a favorable decision in the judicial review action.

4. Whether under 35 U. S. C. 135 foreign applicants for United States patents should be denied the opportunity to contest the question of first inventorship with a United States patentee because while said applicants have submitted *prima facie* evidence of first inventorship in compliance with the Patent Office Rules, which fact has been admitted by the Patent Office, they have not submitted *conclusive* evidence.

5. Whether under 35 U. S. C. 135 a request for an Interference between a pending United States patent application and an issued United States patent can properly be denied on the sole ground that the pending application is unpatentable over the very patent with which an Interference has been requested when said application is allowable in all other respects as required by Patent Office Rule 201, and is in full compliance with all laws and all rules of the Patent Office as to patentability.

Statutes Involved

The following statutory provisions and Rules of the United States Patent Office are involved:

5 U. S. C. 1009

28 U. S. C. 1361

35 U. S. C. 135

Rules 181 to 183 of the Rules of Practice of the United States Patent Office

Rule 201 of the Rules of Practice of the United States Patent Office

Rule 204(b) of the Rules of Practice of the United States Patent Office

They are printed in Appendix A, pages 21 to 29.

Statement

Doyle, Nayler and Rolinson, British subjects, filed a patent application in the United States Patent Office which the Patent Office has agreed is entitled to an effective filing date of August 2, 1957. This application contains, *inter alia,* six claims identical to the only six claims present in Sheehan, United States Patent No. 3,159,617. Before a patent was granted to Sheehan, Doyle, Nayler and Rolinson requested the Patent Office to declare an Interference so that a determination could be made on an *inter partes* basis as to who in fact was the first inventor of subject matter claimed both by Doyle, Nayler and Rolinson, and by Sheehan. The Patent Office, before issuing a patent to Sheehan, suspended prosecution in the Doyle, Nayler and Rolinson case, but without prior warning and without any explanation as to the reasons for such action, the Patent Office improperly issued a patent to Sheehan and rejected the Doyle, Nayler and Rolinson application as unpatentable over the newly issued Sheehan patent. The Patent Office later revealed that it had made a determination on its own that the Sheehan patent was entitled to the benefit of the March 1, 1957 filing date of an earlier filed Sheehan patent application which had been abandoned and that since the filing date of that earlier abandoned Sheehan application was some five months earlier than the August 2, 1957 date given Doyle, Nayler and Rolinson by the Patent Office, an Interference would not be declared. Doyle, Nayler and

Rolinson were refused the opportunity to challenge this ruling before it was finalized and a patent was issued to Sheehan. They have been and still are being denied the right and opportunity to directly question Sheehan as to his right to claim the earlier date that the Patent Office decided, on its own, to give him.

After the Patent Office had issued a patent to Sheehan, Doyle, Nayler and Rolinson again requested an Interference with the now issued Sheehan patent on four occasions. Three affidavits, as well as arguments, have been submitted. These affidavits comprised sworn statements from three of the leading chemists and one, in fact, is from Sir Robert Robinson[1] and proved *prima facie* (Appendix C, page 38[2]) that Sheehan was not and is not entitled to receive the benefit of the March 1, 1957 filing date of his abandoned application, but rather should receive only the benefit of the filing date of the application on which a patent actually issued, which date is almost two years subsequent to the August 2, 1957 effective date of Doyle, Nayler and Rolinson.

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[1] Robert Robinson Kt., O.M., D.Sc., F.R.I.C., F.R.S., Nobel Prize for Chemistry in 1947, former Professor of Chemistry in the Universities of Sydney, Liverpool, St. Andrews, Manchester, University College, London, Oxford (1932-1947), recipient of 22 honorary doctorates and foreign member of Scientific Academies worldwide, including the National Academy of Sciences, Washington, District of Columbia, American Academy of Art and Sciences, Boston, Massachusetts, New York Academy of Science, Philosophical Society of Philadelphia, Pennsylvania, honorary member of the Chemists Club of New York; affidavits were also filed by John Herbert Charles Nayler, a graduate of London University, B.S. and Ph.D. and a Fellow of the Royal Institute of Chemistry in England and Maurice John Soulal, a graduate of London University, B.S. and Ph.D. and a Fellow of the Royal Institute of Chemistry in England.

[2] See especially App. C, page 40, lines 15 to 18, wherein the Patent Office specifically admits that *prima facie* evidence had been submitted.

The Patent Office rules governing the declaration of Interferences, both between pending applications and between a pending application and an issued patent, are promulgated by the Commissioner of Patents pursuant to 35 U. S. C. 135. These rules have the force of law. Rule 201 governs declarations of Interferences generally. Rule 204 (b) governs the quantum of proof required to obtain the declaration of an Interference. That burden is at most that *prima facie* evidence be presented to show that the party requesting the Interference may prevail as to priority of inventorship if an Interference is declared. The Patent Office refused to declare the requested Interference because the proof presented by Doyle, Nayler and Rolinson, while meeting the *prima facie* showing required by the Rules, did not constitute "a conclusive showing" (App. C, page 40). Since the Doyle, Nayler and Rolinson application was under a final rejection in the Patent Office, in order to prevent the Commissioner from holding their application to be abandoned, Doyle, Nayler and Rolinson filed a Notice of Appeal. After the Notice of Appeal was filed, Doyle, Nayler and Rolinson filed a Petition to the Commissioner of Patents and requested that he review the refusal of the Patent Office Examiners to declare an Interference and that he interpret the Interference Rules newly promulgated by him, which had not hitherto been interpreted. The Commissioner delegated the decision on the Petition back to the very section of the Patent Office which had refused to declare the Interference. The Petition was denied and no rule interpretation was issued.

Doyle, Nayler and Rolinson then filed an action in the District Court for the District of Columbia under the provisions of 28 U. S. C. 1361 (Action in the Nature of Mandamus) and/or 5 U. S. C. 1009 (Administrative Procedure

Act) requesting that the District Court exercise its jurisdiction to review the refusal of the Commissioner of Patents to act.

A temporary restraining order staying the Appeal proceeding before the Patent Office Board of Appeals which resulted from the required filing of a Notice of Appeal was signed by District Court Judge Jackson. Doyle, Nayler and Rolinson filed a Motion for a Preliminary Injunction to stay the Board of Appeals proceedings pending outcome of their court action. During Oral Argument, the Patent Office Solicitor offered to join in a request with Doyle, Nayler and Rolinson that the Board of Appeals stay its proceedings. Such a request was filed and all proceedings before the Board have been suspended pending final determination of the case by the Supreme Court.

On a Motion to dismiss brought by the Commissioner of Patents, the District Court dismissed the action.

Doyle, Nayler and Rolinson filed an Appeal to the Court of Appeals for the District of Columbia and the Court of Appeals affirmed the District Court's dismissal.

Reasons for Granting the Writ

1. The District Court and the Court of Appeals for the District of Columbia have refused to review the action of the Commissioner of Patents in refusing to declare an Interference between a pending patent application and an issued patent after all the Commissioner's rules had been complied with and have also refused to review the Commissioner's refusal to interpret his Interference Rules. In seeking Court review, Doyle, Nayler and Rolinson relied

upon 5 U. S. C. 1009 and 28 U. S. C. 1361. 5 U. S. C. 1009 provides for judicial review of Administrative agency action, except insofar as a statute specifically precludes judicial review or insofar as the agency action is by law committed to agency discretion.

A statute purporting to preclude judicial review must clearly demonstrate that such was the intention of Congress. See *Freeman* v. *Brown* (CA Ga. 1965), 342 F. 2d 205 and *Barefield* v. *Byrd* (CA Miss. 1963), 320 F. 2d 455, cert. den. 376 U. S. 928. In *Word* v. *U. S.* (DC Ala. 1963), 223 F. Supp. 614 the District Court sitting in Alabama found that it had the right and duty upon proper application to judicially review the action of any administrative agency.

The Commissioner has failed to point out any statute which specifically exempts his action from judicial review. His action is not committed to agency discretion. It is, therefore, important for Federal jurisdiction to be exercised so that administrative agencies may not be allowed to run untrammeled over applicants who appear before them. While the present case deals only with a decision of the Commissioner of Patents, the case as a whole has wider application, because if the Commissioner of Patents may refuse to act in response to a properly framed Petition invoking action and if this refusal to act is unreviewable, any other government agency can act in a similar manner and thereby insulate itself from Federal judicial review by merely declining to act, thus leaving the aggrieved party without any viable remedy.

5 U. S. C. 1009 has in the past been used as a proper basis for obtaining judicial review of actions of the Commis-

sioner of Patents. Moreover, the Federal Bar News, Volume 13, No. 2, February 1966 at page 77, states that defending actions seeking review of decisions of the Commissioner of Patents under the Administrative Procedure Act is an integral part of the job of the Patent Office Solicitor.

In the case of *In re Walker* (CCPA 1963), 324 F. 2d 977, the Solicitor himself suggested that review of the matter in question might be had by Petition to the Commissioner followed by a civil action in the District Court for the District of Columbia under 5 U. S. C. 1009. (See especially page 985, note 2.) In *Winkler* v. *Ladd, Commissioner of Patents* (DC D. C. 1963), 221 F. Supp. 550, the District Court for the District of Columbia accepted jurisdiction of an action under 5 U. S. C. 1009 which sought review of the Commissioner of Patents' refusal to revive an abandoned patent application (which is an area in which the Commissioner possesses a good deal of discretion).

The Federal Courts have jurisdiction to set aside arbitrary or capricious agency action. See *General Motors Corp.* v. *U. S.* (DC Mich. 1962), 207 F. Supp. 641; *Estrada* v. *Ahrens* (CA Fla. 1961), 296 F. 2d 690. In *Cobb* v. *U. S.* (DC Ark.), 240 F. Supp. 574, the Court specifically stated that the Administrative Procedure Act, namely Sections 1001 et seq. deals with judicial review of any act or order of an administrative agency which aggrieves or injures any party and which action is not specifically excluded by Congress from judicial review. Petitioners' case is of particular widespread importance because foreign applicants who are already discriminated against by U. S. C. 104, wherein foreign applicants are prohibited from proving dates on which work was actually done outside the United

States on their invention, are here being denied due process of law. The principles involved in this case also affect United States applicants. The questions of rule interpretation and burden of proof will continue to arise as long as Interferences are still a part of our patent law.

5 U. S. C. 1009 was enacted to protect applicants before all administrative agencies from insulation by that agency against judicial review of its decisions.

In a very recent case decided in 1964 by the Court of Appeals for the District of Columbia, *Gonzalez et al.* v. *Freeman, Secretary of Agriculture,* 334 F. 2d 570, that Court reviewed action by the Secretary of Agriculture which was challenged under 5 U. S. C. 1009 as a denial of due process. The Court stated that it made no difference whether the action was challenged substantively as being arbitrary or capricious, or procedurally as denying minimum safeguards. Administrative agency action was reviewable unless immunity therefrom was plainly the manifested intention of Congress.

28 U. S. C. 1361 provides for an action in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to plaintiff.

Mandamus is properly employed to compel the performance of certain decisions which involve judgment and discretion. See *Parrott* v. *Cary* (DC Colo. 1964), 234 F. Supp. 572 and Moore's Federal Practice, Volume 7A, JC-535. See also *Sleeth* v. *Dairy Products Co., of Uniontown,* 228 F. 2d 165, cert. den. 351 U. S. 966 and *Goldberg* v. *Hoffman* (CA 7—1955), 226 F. 2d 681. It is also clear that mandamus lies to compel the person in whom discretion is lodged to pro-

ceed with its exercise. See *Connelt* v. *City of Jerseyville* (CCA Ill. 1942), 125 F. 2d 121; *Higginson* v. *Schoeneman* (CA D. C. 1951), 190 F. 2d 32; *Thomas* v. *Unison* (App. D. C. 1946), 153 F. 2d 636. The Court of Appeals for the District of Columbia also expressly approved a civil action for an injunction to deal with an administrative agency order in cases where there is no statutory appeal. See *Agnew* v. *Board of Governors of the Federal Reserve System* (CA D. C. 1946), 153 F. 2d 785, rev'd other grounds 329 U. S. 441.

In the case of *Commissariat A L'Energie Atomique* v. *Watson, Commissioner of Patents* (CA D. C. 1960), 274 F. 2d 594, the Court of Appeals reversed the District Court for the District of Columbia which had granted a motion to dismiss filed by the Commissioner of Patents on the ground that the complaint involved failed to state a cause of action and that the Court lacked jurisdiction over the subject matter. The complaint in that case sought review of the refusal of the Commissioner of Patents to revive an abandoned patent application as well as the refusal of the Patent Office Board of Appeals to reconsider its affirmance of the Patent Office Examiner's denial of a patent. The plaintiff involved asserted mandamus jurisdiction over the Commissioner of Patents for his refusal to exercise discretion and to make a finding in accordance with 35 U. S. C. 133, which deals with the revival of abandoned patent applications. The Court of Appeals went on to say that the Commissioner of Patents possesses a large measure of discretion in the question of reviewing abandoned patent applications, but even so, the statutes do not purport to make discretion plenary and unreviewable. The Commissioner's discretion cannot remain wholly uncon-

trolled. Review jurisdiction existed and the Commissioner should submit findings, especially where the plaintiff involved asserts the ability to prove facts that would cause the Commissioner in the proper exercise of his discretion to hold in their favor.

In *Kingsland, Commissioner of Patents* v. *Carter Carburetor Corp.* (CA D. C. 1945), 168 F. 2d 565, cert. den. 79 U. S. P. Q. 453, the Court of Appeals voided the Commissioner of Patents' order reversing action taken by an interference Examiner.

The United States Court of Customs and Patent Appeals in *In re Wiechert,* 152 U. S. P. Q. 247 stated that Decisions of the Commissioner of Patents were not appealable to the CCPA. The proper remedy is by mandamus in the District Court (page 255).

On two separate occasions, the Supreme Court of the United States affirmed mandamus jurisdiction to review actions of the Commissioner of Patents. *Butterworth, Commissioner of Patents* v. *United States ex rel. Hoe et al.,* 112 U. S. 50 and *United States ex rel. Steinmetz* v. *Allen,* 192 U. S. 543.

2. One of the reasons alleged by the Commissioner of Patents for refusing to act on the Doyle, Nayler and Rolinson petition and refusing to review the Interference Rules which he himself has promulgated and further as a reason why the Federal Court should not exercise their right to judicially review his action, is that Doyle, Nayler and Rolinson should proceed by Appeal to the Patent Office Board of Appeals on other separate and distinct issues. The Board of Appeals, however, does not have either the power or authority to in any way review the decision of

the Commissioner of Patents which is sought to be reviewed. The Board of Appeals may only deal with these other issues, none of which was before the District Court, Court of Appeals or this Court. The fact that Doyle, Nayler and Rolinson may argue other issues before the Patent Office Board of Appeals does not make the action on which review is sought non-final. Moreover, favorable action by the Court in this case would render the issues which might be argued before the Patent Office Board of Appeals moot. All of the issues which might be raised before the Board of Appeals are completely different from those in this case. Furthermore, proceeding before the Board of Appeals would prevent Doyle, Nayler and Rolinson from obtaining the testimony of Sheehan which they believe should be brought out in an Interference in order to ensure that they are found to be the first inventors. The Patent Office has succeeded up until the present time in preventing judicial review of the Commissioner's decision by confusing the issues and leading the Courts below to believe that the Board of Appeals should hear this case on other issues and in the event that Doyle, Nayler and Rolinson are dissatisfied with the decision of the Board of Appeals, that they may then return to the District Court and/or the Court of Appeals under the provisions of 35 U. S. C. 145.

This deprives petitioners of due process of law because in view of the fact that the issues before the Board of Appeals are completely different from those on which review is sought under 35 U. S. C. 1361 and 5 U. S. C. 1009, it is seriously doubted that adverse decision by the Board of Appeals on these different issues, could be reversed by arguing as new issues on Appeal to the District Court for

the District of Columbia, the very issues in this case. Clearly, the CCPA has no jurisdiction to hear such issues, *In re Wiechert, supra.* Doyle, Nayler and Rolinson are, therefore, at present being impaled on the horns of a dilemma. The District Court and the Court of Appeals for the District of Columbia have refused to exercise jurisdiction and have refused to review the decision of the Commissioner of Patents stating that if Doyle, Nayler and Rolinson are aggrieved by the decision of the Board of Appeals, they have the right to come back to the District Court and the Court of Appeals under 35 U. S. C. 145 after an adverse decision of the Patent Office Board of Appeals. On the other hand, Doyle, Nayler and Rolinson have no way of presenting the issues presented in this proceeding before the Board of Appeals since under the rules of the Patent Office the Board of Appeals has a separate function and considers only appeals on the merits and can neither interpret Interference rules nor review decisions issued by the Commissioner of Patents. If this Court fails to exercise jurisdiction, Doyle, Nayler and Rolinson will be left without a remedy and without a forum in which to bring forth the issues which are of grave importance for all applicants for United States patents and which also transcend the Patent Office and affect the actions of all government administrative agencies in view of the procedural approach which the Patent Office has attempted to take.

3. 35 U. S. C. 135 allows the Commissioner of Patents some measure of discretion as to the declaration of Interferences. Pursuant to that discretion, the Commissioner has promulgated rules setting forth the requirements to be met before an Interference will be declared. Effective July 1, 1965 a new set of rules was promulgated by the Com-

missioner. The Interference which was sought in this case was initially sought under the provisions of the previous rules but Doyle, Nayler and Rolinson are equally willing to have their case decided under the newly promulgated rules, because these will expedite the Interference. The Commissioner had not interpreted his new rules prior to the request from Petitioners. Doyle, Nayler and Rolinson have complied with the language and the spirit of the new rules, yet the Patent Office has refused to declare an Interference. The basis for this refusal was that Doyle, Nayler and Rolinson had failed to meet a greater burden of proof than that required by the rules. Rule 204(c) which governs the declaration of Interferences where the dates of invention of the parties are further apart than in this case, specifically requires only *prima facie* evidence of first inventorship by the later party, for the Interference to be declared (App. A, pages 28-29). Rule 204(b) under which the present Interference is sought is concerned with situations where the alleged dates are closer to each other than under Rule 204(c). Therefore, the proof requirement of Rule 204(b) is certainly not greater than the *prima facie* evidence requirement of Rule 204(c). Doyle, Nayler and Rolinson have submitted *prima facie* evidence of first inventorship in the form of affidavits and arguments, the affidavits being sworn to by three leading chemists including one of the foremost in the entire world, Sir Robert Robinson. The Patent Office (App. C, page 40) admitted that Doyle, Nayler and Rolinson had submitted *prima facie* evidence, but rejected the proof and refused to declare an Interference on the ground that they had not submitted conclusive evidence. Nowhere in the rules is there a requirement that conclusive evidence be presented. The Patent Office has, in effect, required a greater burden of proof

than Doyle, Nayler and Rolinson would have to sustain if they actually obtained a declaration of an Interference and were contesting first inventorship with Sheehan. The prevailing case law is clear in that it is only necessary for even a junior party in an Interference to prevail by a *preponderance* of the evidence, see *Cramer* v. *Kirkwood and Torre* (CCPA), 305 F. 2d 486, and *Apstein* v. *Brimley and Cance* (PO Bd. Pat. Inter.), 133 U. S. P. Q. 604. To correct this misinterpretation and misapplication of these new Interference rules, Doyle, Nayler and Rolinson, under the provisions of Rules 181 to 183 promulgated by the Commissioner, filed a Petition to the Commissioner of Patents and requested that he exercise his supervisory authority as provided in those rules, review the action of the Examiners involved and interpret the meaning of Rule 204(b) with which petitioners believe they had clearly and unquestionably complied. The Commissioner referred decision on Petitioners' petition back to Group 120 in the Patent Office which was the very group in the Patent Office which had misinterpreted the rules and refused to declare the Interference in the first instance. The manager of Group 120 rendered the decision on the petition and refused to review the action or to issue any interpretation of the Interference rules. In a case decided July 6, 1966, *Wenner* v. *Koch*, 152 U. S. P. Q. 291, Wenner petitioned the Commissioner of Patents objecting to Patent Office action under Interference Rule 204(c). First Assistant Commissioner Reynolds issued an interpretation of Rule 204(c) with respect to that specific situation.

4. In the recent case of *Brenner* v. *Manson*, 383 U. S. 519, this Court considered a potential Interference situation. In that case, however, even had Manson prevailed

in the Interference, he would have been refused a patent on the ground that his application failed to comply with 35 U. S. C. 112 because it did not teach a utility for the product produced by the process sought to be patented as required by 35 U. S. C. 101. The present case presents an entirely novel and hitherto untried approach by the Patent Office for refusing to declare an Interference which is contrary to law. The Doyle, Nayler and Rolinson application fully complies with all statutory provisions and specifically 35 U. S. C. 101 (utility) and 35 U. S. C. 112 (full and complete disclosure of the invention). If Petitioners win the Interference, a patent must be issued to them because they have complied with all the legal requirements of patentability. The Patent Office has put forward a new requirement in this case which is not supported either by Statute or case law, namely, that before an Interference will be declared, Petitioners' application must be patentable over the Sheehan patent with which the Interference is sought. This is a perverted reading of Patent Office Rule 201. Petitioners' case contains all the six claims of the Sheehan patent. Under the Manual of Patent Examining Procedure (M. P. E. P.) Section 1101.02(a) issued by the Commissioner, the only way Petitioners' application can be patentable over Sheehan's patent is through an Interference. That Section requires the institution of an Interference. Under Rule 204(b) of the Commissioner's Rules, an Interference will be declared between an application and a patent, when the applicant submits proof of first inventorship. Here, *prima facie* proof was rejected as insufficient because the Patent Office called for *conclusive* evidence.

The Commissioner has refused to correct the administrative errors and has refused even to interpret his new Interference rules as requested by Petitioners although Rule 204(c) was interpreted in response to a Petition to the Commissioner in the recent case of *Wenner* v. *Koch, supra,* after Petitioners had commenced their Court action. The Commissioner has taken the position that this arbitrary and capricious action is not reviewable and that he is, in effect, completely insulated from any judicial review. Such insulation amounts to a denial of due process of law to applicants. This is no legal basis for asserting that applicants before administrative agencies may not obtain judicial review of final and otherwise unreviewable agency action.

Doyle, Nayler and Rolinson have soundly based their request for judicial review both under 28 U. S. C. 1361 and 5 U. S. C. 1009 and have presented for judicial review issues which cannot be decided by any other judicial or quasi-judicial body, except the Federal Courts. The Commissioner of Patents has refused to act after his supervisory authority and jurisdiction were invoked pursuant to his very own rules. While under *Brenner* v. *Manson, supra,* a patent was held not to be a hunting license, it should correspondingly be true that that Patent Office is not a private game preserve where the Commissioner of Patents may act as he wishes, fully protected and insulated from judicial review.

CONCLUSION

For the foregoing reasons and in view particularly of both the novelty of the situation presented here and the wide-ranging consequences, not only in terms of future Patent Office action, but in terms of future action of all government administrative agencies, this Petition for a writ of certiorari should be granted.

Respectfully submitted,

ALBERT L. JACOBS
Counsel for Petitioner

October 13, 1967

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APPENDIX A

Title 5, United States Code

§ 1009. *Judicial review of agency action.*

Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion—

(a) Right of review.

Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

(b) Form and venue of proceedings.

The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

(c) Acts reviewable.

Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial re-

view. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the action meanwhile shall be inoperative) for an appeal to superior agency authority.

(d) Relief pending review.

Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

(e) Scope of review.

So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold un-

lawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 1006 and 1007 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error. (June 11, 1946, ch. 324, § 10, 60 Stat. 243.)

EFFECTIVE DATE

Section effective three months after June 11, 1946, see section 1011 of this title.

Title 28, United States Code

§ 1361. *Action to compel an officer of the United States to perform his duty.*

The district courts shall have original jurisdiction of any action in the nature of mandamus to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff.

(Added Pub. L. 87-748, § 1(a), Oct. 5, 1962, 76 Stat. 744.)

35 U. S. C. 135. Interferences. (a) Whenever an application is made for a patent which, in the opinion of the Com-

missioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understand-

ing and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

United States Patent Office Rules of Practice in Patent Cases

Petitions and Action by the Commissioner

181. Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of a final fee (rule 317).

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within sixty days from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) Determination of petitions of various kinds may be delegated by the Commissioner to the Supervisory Examiners or to the Solicitor and Law Examiners.

182. Questions not specifically provided for. All cases not specifically provided for in these rules will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

183. Suspension of rules. In an extraordinary situation, when justice requires any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

Interferences: Definition, Preparation, Declaration

201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title, and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

204. Interference with a patent; affidavit by junior applicant. (a) The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

(b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the interference will be declared, shall file an affidavit that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective filing date of the patentee.

(c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits by himself

and by one or more corroborating witnesses, supported by documentary evidence if available, setting out a factual description of acts and circumstances which would prima facie entitle him to an award of priority relative to the effective filing date of the patentee, and accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the effective filing date of the patentee. Upon a showing of sufficient cause, an affidavit on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patentee may be accepted in lieu of an affidavit by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patentee is alleged, and if so, the interference will be declared.

APPENDIX B

UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 20,297

FRANK PETER DOYLE, *et al.*,

Appellants,

v.

EDWARD J. BRENNER,
Commissioner of Patents,

Appellee.

Appeal from the United States District Court
for the District of Columbia

Decided July 21, 1967

Mr. Albert L. Jacobs, Jr., with whom *Messrs. Albert L. Jacobs and James W. Dent* were on the brief, for appellants. *Mr. James E. Bryan* also entered an appearance for appellants.

Mr. Joseph Schimmel, Solicitor, United States Patent Office, for appellee.

Before BAZELON, *Chief Judge*, McGOWAN and LEVANTHAL, *Circuit Judges*.

LEVANTHAL, *Circuit Judge*: This case arises out of proceedings in the Patent Office in which appellants applied for a patent involving phenoxacetylpenicillanic acid

(6-APA), a reagent in a penicillin producing process. After appellants' application was rejected as unpatentable, the District Court reversed a Patent Office determination that another application involving 6-APA, that of a Mr. Sheehan, was unpatentable on grounds of obviousness.[1] Accordingly, appellants asked for reconsideration of their rejection and for a declaration of interference with Sheehan. The Patent Office notified appellants that the prosecution of their application was being suspended pending a determination of whether to declare an interference. Then appellants were advised that a patent had been issued to Sheehan and that their application was finally rejected as unpatentable, the Sheehan patent being used as the critical reference against them.

The basis for this rejection was that the Sheehan patent described 6-APA and was entitled to a filing date earlier than the earliest date of conception claimed by appellants.[2] Although the Sheehan application had a filing date later than appellants', it was the continuation-in-part of a parent application, also describing 6-APA, having a filing date earlier than appellants. The examiner ruled the Sheehan patent was entitled to the filing date of the parent application.

Appellants argued that Sheehan was not entitled to the filing date of the parent because 6-APA, though mentioned in the parent application, had not actually been made at that time. The examiner agreed that applicants had made a prima facie showing that Sheehan had not made 6-APA

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[1] Massachusetts Institute of Technology v. Ladd, 231 F. Supp. 146 (1964).

[2] *See* 35 U. S. C. §102(e) (1964).

under the parent. He ruled, however, that in the absence of a conclusive showing by appellants overcoming his determination that Sheehan was entitled to the parent date, appellants' application was unpatentable over Sheehan, and no interference could be declared.

The Commissioner denied appellants' petition for review stating that the examiner's rejection of appellants' application on patentability grounds rather than declaring an interference was permissible under the interference rules, and that it was for the Patent Office Board of Appeals to decide whether the examiner had erred in concluding that appellants' application was unpatentable over the Sheehan patent. Appellants' action for review of the Commissioner's decision was dismissed by the District Court and they appeal.

Although the parties have briefed and argued the lawfulness of the procedure followed by the Patent Office,[3] which was apparently approved by the District Court, we affirm on the ground that the case is premature for judicial consideration, since there was no final agency action of the Patent Office.[4] Even assuming that the Commissioner's approval of the examiner's procedure in deciding patentability before priority is not subject to reconsider-

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[3] Appellee contends that the patentability of an application is a precondition to declaration of interference (*see* Patent Office Rule 201(b)), and that the examiner's approach of deciding patentability before priority has solid support in precedent. Brenner v. Manson, 383 U. S. 519, 528, n. 12 (1966); Application of Rogoff, 261 F. 2d 601, 606 (C. C. P. A. 1958). Appellants insist that the precedents involved bars to patentability on grounds other than the patent of the potential interferant, so that the applicants could not have gotten a patent even if they prevailed in the interference.

[4] Phillips Petroleum Co. v. Brenner, —— U. S. App. D. C. ——, —— F. 2d —— (No. 20626, June 29, 1967).

ation within the Patent Office,[5] this was only an interlocutory ruling in the consideration of appellants' application. Even assuming arguendo that appellants could sustain the burden of showing that the approach is an abuse of discretion or in violation of Patent Office rules,[6] the courts will not consider the problem until there is a final agency decree rejecting appellants' application for patent. As matters stand, appellants may still obtain a ruling from the Patent Office Board of Appeals that their claims are patentable. If their application is finally rejected, they will then be in a position to argue in court that rejection was the unlawful product of an improper and arbitrary procedure.

Affirmed

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[5] We have not tried to probe the limit of what we understand to be the general Patent Office approach that a board of appeals, being an adviser to the Commissioner, is not free to overrule his prior procedural determinations. We would hope, however, that there is a means available for a board of appeals, if it concluded that an imprudent procedural ruling by the examiner had seriously diluted substantive rights, to bring the matter before the Commissioner for a further look without feeling powerless even to initiate reconsideration merely because the Commissioner had earlier determined that the examiner's procedural ruling had not been shown to have been arbitrary, a determination made on a record limited to a bare procedural issue, without substantive perspective.

[6] *Compare* Newcastle Airport Comm'n v. CAB, —— U. S. App. D. C.——, 371 F. 2d 733 (1966).

We note that it seems to be established Patent Office practice, in a situation where an applicant requests an interference with a pending application and does not swear behind what the examiner deems to be the effective filing date of the potential interferant, for the Patent Office to issue a patent to the senior applicant and then use that patent as a patentability reference against the junior applicant. *See* Manual of Patent Examining Procedure §1101.01(i) (as revised July 5, 1965).

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF COLUMBIA

Civil Action No. 2928-65

FRANK PETER DOYLE,
JOHN HERBERT CHARLES NAYLER,

and

GEORGE NEWBOLT ROLINSON,

Plaintiffs,

—v.—

EDWARD J. BRENNER,
Commissioner of Patents,

Defendant.

ORDER

Upon consideration of defendant's Motion to Dismiss, memoranda of the parties relating thereto, and the oral arguments advanced at the hearing had the twenty-second day of March, 1966, it is this 25th day of March, 1966,

ORDERED, that the Motion to Dismiss be, and it is hereby granted, and that the Complaint be, and it hereby dismissed. See *Brenner* v. *Manson*, 148 USPQ 689, 693 (1966).

JOSEPH R. JACKSON
United States District Judge

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Address only
The Commissioner of Patents
Washington, D. C. 20231

Group 120
GM:aw

Ex parte Frank Peter Doyle et al.
Serial Number 826,491
Filed: July 13, 1959
For: Substances Produced From
Penicillin-Producing Moulds

Petition

This petition filed October 22, 1965 and stated to be under the provisions of Rules 181 to 183 seeks to have the Examiner directed to initiate an interference between this application and Sheehan Patent Number 3,159,617, petitioners having copied the claims of the said patent.

The Examiner's refusal to initiate an interference is based on his contention that the copied claims are unpatentable to petitioners in view of the Sheehan patent and its parent, abandoned application Serial Number 643,260.

It is clear that Rule 181 does not contemplate any direct review of a rejection by way of petition since rejections are subject to appeal to the Board of Appeals. Rule 181 does contemplate invoking the supervisory authority of the Commissioner in "appropriate circumstances". Review

of a rejection by way of petition would be appropriate only where the rejection is not presented in such form that its propriety could be properly reviewed by the Board of Appeals. In the present case the ground of rejection has been set forth and related to the Patent Laws. The Examiner has in his final rejection and subsequent actions commented on petitioners' arguments. A clear issue is thus presented for consideration by the Board of Appeals.

No specific argument has been made that the instant situation presents questions not provided for by the Rules or that are appropriate for suspension of any Rule, and it is not seen that Rule 182 or 183 are applicable.

Petitioners suggest that an interference might be declared and the question of patentability deferred. They state that they would have to prove that they would prevail in a determination of priority in order to overcome the rejection and then prove the entire case all over again during interference. While disclosure or evidence necessary to prove priority is not necessarily commensurate with that required to support allowance of a claim or to support rejection of a claim, it appears that petitioners' arguments should not forestall the application of Rules 201(b) and 205(a) to determine patentability first. Even if the Rules be construed as permissive of determining priority before patentability, it is neither apparent that such action is required by applicable Rules or Statutes nor that the Examiner has acted arbitrarily in the instant case to determine patentability first.

Petitioners refer to four "Questions Presented". Since these appear to relate to matters to be treated after the

conditions of Rules 201(b) and 205(a) are met, they do not appear controlling of this petition.

The petition is denied.

Sgd. G. D. MITCHELL
George D. Mitchell
Acting Director
Chemical Examining Operation

JACOBS AND JACOBS
521 Fifth Avenue
New York, New York

APPENDIX C

Paper No. 39

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Jacobs and Jacobs
521 Fifth Avenue
New York, New York

In Reply Please Refer To:

Applicant: Frank Peter Doyle et al.
Ser. No. 826,491
Filed: July 13, 1959
For SUBSTANCES PRODUCED FROM PENICILLIN-PRODUCING MOULDS

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

This is in response to the amendments received September 8 and 29, 1965.

Claims 1, 3-7, and 15-25 remain in the application.

Claims 3, 4, 15, 18, and 21 stand allowed.

Claims 1, 5-7, 16, 17, 19, 20, and 22-25 stand finally rejected as unpatentable over the Sheehan patent for reasons particularly pointed out in Paper No. 32.

Applicants argue that Sheehan is not a reference against them as of the filing date of the Sheehan parent since the sole example in the parent which supports the claims of the patent is subject to serious criticism from a technical standpoint. In other words, applicants question whether or not Sheehan actually made phenoxyacetylpenicillanic acid. If Sheehan did not make this product, *and this fact is proven,* then it would appear that Sheehan could not rely on the parent. If Sheehan can not rely on the parent then applicants will be entitled to contest priority of the invention via interference proceedings.

Therefore, we arrive at the basic issue which remains unchanged in spite of the affidavits submitted in support of applicants' position: Did Sheehan make phenoxyacetylpenicillanic acid? Sheehan presumably conducted the experiment or at least supervised it. He intended to make the product. The reactants which Sheehan employed *could* produce the desired product under the specified conditions. Sheehan, a skilled chemist working in the art, says he *did make the intended product.*

Affidavits submitted in support of applicants' position provide expert opinion as to why Sheehan did not produce the indicated product. While the affidavits present perfectly plausible explanations in support of applicants' position, they *have* to be based on *speculation.* Affiants cannot know for *certain* what Sheehan made.

Thus, the present status of the case is this: Unquestionably competent chemists have disagreed on the results of a chemical experiment. The one who *was there believes he produced a given product.* Those who *were not there believed the product was probably not produced* and, even if

it was produced, *its presence was not established by conclusive scientific procedures* so that its existence or non-existence will never be established as a matter of absolute fact.

Under the circumstances, logic would seem to dictate favoring the position of the trained observer-in-fact over the hypothesis of the trained non-observer.

Accordingly, applicants' position and the arguments and affidavits in support thereof are not deemed sufficient to overcome the Sheehan parent.

The Examiner is not unaware of the ramifications of this decision. First, the position taken by the Examiner is that in order for applicants to prevail, they must *conclusively* establish error in the Sheehan parent. This they probably can *never* do. The *best* that could be done is for applicants to present expert opinion to raise a *prima facie* question of error. It would appear that this burden been [sic] sustained.

Applicants undoubtedly consider the decision as harsh since, from their viewpoint, one who has erred is placed in a favored position because of the error. But, assuming that Sheehan did not err (and the rejection is based on this assumption), it would be equally harsh to put patentee to the expense of a costly interference proceeding simply because others hypothesize error. If there is doubt, doubt should be resolved in favor of the patentee.

It is also acknowledged that applicants cannot be said to be challenging the *validity* of a U. S. patent. They are challenging the *effective date* of the patent as a reference—a completely unrelated thing.

Moreover, it is further admitted that applicants wish to contest priority of a *generic* invention. If there is no support in a parent application of a U. S. patent for a generic inventive concept, the question arises whether a patent having claims directed to *a genus* can rely on a parent having no reference to the genus but only a species thereunder to give an earlier effective filing date to the generic invention.

However, applicant has presented no decisions on these points favorable to him. The decisions which are relied on do not deal with analogous factual circumstances, and therefore, are not controlling.

The law which appears to control is that of In re *Heritage,* 86 U. S. P. Q. 160, and Ex parte *Schacter,* 796 O. G. 881. These decisions hold that a parent abandoned application is a reference in the appropriate circumstances. Thus, the Sheehan parent, being a reference, renders the claims unpatentable to applicants. And if the claims are not patentable, it is axiomatic that there can be no interference. In re *Rogoff,* 120 U. S. P. Q. 185. Applicants' attempt to distinguish Rogoff on the grounds that it deals with non-chemical subject matter is not convincing.

Admittedly, the present fact situation is not on all fours with In re *Heritage, supra.* Here there is a question as to what the parent actually teaches. Even if the parent is available as a reference, it is in fact a valid reference? The rejection stems from a belief that it is a valid reference against the instant claims.

In view of the foregoing, the question of an interference is seen to be secondary to the *immediate* problem of patentability. It is this latter issue which is now on appeal to the Board. The decision of the Board in deciding patent-

ability will also determine the question of the interference. If the rejection is sustained, no interference can be declared. If the rejection is reversed, those claims which are allowed and which correspond to the claims of Sheehan can be placed in interference.

The application is being returned to the Board of Appeals to await perfection of the appeal.

NICHOLAS S. RIZZO
Examiner

JWAdams:meh
WO7-2805

M. P. E. P. §1101.02(a) COPYING CLAIMS FROM A PATENT

A large proportion of interferences with a patent arise through the initiative of an applicant in copying claims of a patent which has come to his attention through citation in an Office action or otherwise.

If, in copying a claim from a patent an error is introduced by the applicant, the Examiner should correct applicant's claim to correspond to the patent claim. A notation should be added to his letter (POL 76) stating that the correction has been made.

However, in some instances the Examiner observes that certain claims of a patent can be made in a pending application and, if the patent is not a statutory bar, he must take steps to avoid the issuance of a second patent claiming the same invention without an interference. The practice set forth hereinbelow applies when an issued patent and a pending application are not commonly assigned. If there is a common assignment, a rejection as outlined in

305 should be made if an attempt is made to claim in the pending application the same invention as is claimed in the patent.

A patent claiming the same invention as that being claimed in an application can be overcome only through interference proceedings. Where the effective filing date of the application is prior to that of the patented application, no oath is required. Otherwise the applicant must submit an affidavit that he made the invention prior to the filing date of the patent, even though there was copendency between the two applications. The affidavit may be made by persons other than applicant. Cf. 715.04. It is within the discretion of the Examiner to require the same showing of facts in an affidavit under Rule 204 as is required in an affidavit under Rule 131. This discretion should be governed by the circumstances of the case, such as the difference in filing dates, complexity of the invention, etc. However, in all cases where claims are copied from a patent, and the applicant's effective filing date is more than thirty days later than the patentee's filing date, the Examiner, before declaring an interference, shall require applicant to file an affidavit *setting forth sufficient facts to make out a prima facie case for priority relative to the filing date of the patentee.* (Basis: Notice of April 30, 1963.)

If the filing date of the patent precedes the filing date of the application and the patent is not a statutory bar against the application, the claims of the application should be rejected on the patent. If it appears that the applicant is claiming the same invention as is claimed in the patent and that the applicant is able to make one or more claims of the patent, a statement should be included in the

rejection that the patent cannot be overcome by an affidavit under Rule 131 but only through interference proceedings. Note, however, 35 U. S. C. 135, 2d par. and section 1101.02(f). If the applicant controverts this statement and presents an affidavit under Rule 131, the case should be considered special, one claim of the patent which the applicant clearly can make should be selected, and an action should be made refusing to accept the affidavit under Rule 131 and requiring the applicant to make the selected claim as well as any other claims of the patent which he believes find support in his application. If necessary, the applicant should be required to file the affidavit and showing required by Rule 204. A time limit for response should be set under Rule 203. In any case where an applicant attempts to overcome a patent by means of affidavit under Rule 131, even though the Examiner has not made a rejection on the ground that the same invention is claimed in the patent, the claims of the patent should be examined and, if applicant is claiming the same invention as is claimed in the patent and can make one or more of claims of the patent, the affidavit under Rule 131 should be refused, and an action such as outlined in the preceding part of this paragraph should be made. If necessary, the requirements of Rule 204 should be specified and a time limit for response should be set under Rule 203.

In the Supreme Court of the United States

OCTOBER TERM, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON, PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

1. Petitioners filed an application with the United States Patent Office for a patent on phenoxacetylpenicillanic acid ("6-APA"), a reagent in a penicillin producing process (Pet. App. 30–31).[1] Petitioner's application was rejected by a Patent Office examiner as unpatentable because a patent on similar claims had already been granted to a Mr. Sheehan (Pet. App. 31). On June 21, 1965, the petitioners, pursuant to 35 U.S.C. 134, appealed the rejection of their claim to the Patent Office Board of Appeals (J.A. 22).

[1] "Pet. App." refers to the appendix to the petition for a writ of certiorari. "J.A." refers to the Joint Appendix in the court of appeals, a copy of which is being lodged with this Court.

282-073—67

Rather than prosecuting that appeal, petitioners sought to have the Patent Office initiate an "interference" proceeding pursuant to 35 U.S.C. 135.[2] Although recognizing that petitioners would have a right to contest the validity of the Sheehan patent through an intereference proceeding on the ground that their application alleged a date of conception earlier than the date of filing of the Sheehan application, the examiner found that the Sheehan application on which the patent was granted referred back to an earlier Sheehan application which clearly predated the date of invention claimed by petitioners.[3] The examiner ruled,

[2] 35 U.S.C. 135 authorizes the Commissioner of Patents to institute an administrative adversary proceeding, called an "interference," in which the question of priority between rival claimants is determined by a board of patent interferences.

[3] The examiner rejected petitioners' contention that the date of the original Sheehan application could not be used as a filing date because the reagent 6-APA, although mentioned in Sheehan's application, had not been made at that time. In so ruling, the examiner noted that Sheehan, who was present at the original experiment, testified that 6-APA had been produced and that the opinion evidence to the contrary offered by petitioners had not proved that it could not have been produced.

Contrary to petitioners' assertion (Pet. 14–16), the instant case does not raise any question with respect to the quantum of proof necessary to institute an interference. We agree with petitioners that Patent Office Rule 204(c), 37 C.F.R. 1.204(c), requires, as a precondition to the declaration of an interference, that an applicant must submit "prima facie" (not "conclusive") proof entitling him "to an award of priority relative to the effective filing date of the patentee." However, as we read the Patent Office examiner's decision in the instant case, the examiner merely intended to state that petitioners had not met the requirement of Rule 204(c) since, instead of establishing their own prior date of conception, petitioners attempted to attack the validity of Sheehan's earlier application. In any event, whether or not the examiner erred in this particular case in

that since the original Sheehan application showed the production of 6–APA, petitioners' application had been properly rejected as unpatentable and petitioners were not entitled to an interference proceeding. Finally, the examiner noted that the question of patentability was then on appeal and that the "decision of the Board in deciding patentability will also determine the question of the interference" (Pet. App. 38–42).

Petitioners then filed a petition with the Commissioner of Patents in which they sought to have the Commissioner direct the examiner to initiate an interference between their application and the Sheehan patent. The Commissioner of Patents, through the Acting Director of the Chemical Engineering Operation, denied this petition on the ground that the examiner's determination, that petitioners' claims were not patentable because of the earlier date of the original Sheehan patent, presented the issue, which the petition sought to raise, in a clear form that could be considered by the Patent Office Board of Appeals (Pet. App. 35–37).

Petitioners thereafter instituted this action in the United States District Court for the District of Columbia, purportedly under 28 U.S.C. 1361 and Section 10 of the Administrative Procedure Act, 5 U.S.C. 1009, seeking a judgment in the nature of mandamus (1) directing the Commissioner of Patents to institute an interference proceeding, and (2) staying further

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applying the Patent Office Rules does not present any question of general significance warranting review by this Court. Moreover, the examiner's decision is subject to review by the Patent Office Board of Appeals. See *infra*, p. 4.

proceedings in petitioners' appeal before the Patent Office Board of Appeals until a final decision was obtained in the requested interference (J.A. 2–6, 20–24). The district court denied petitioner's motion for a preliminary injunction (J.A. 31), and granted the Commissioner's motion to dismiss because of lack of jurisdiction and failure to state a claim upon which relief can be granted (Pet. App. 34). The court of appeals unanimously affirmed on the ground that "the case is premature for judicial consideration, since there was no final agency action of the Patent Office" (Pet. App. 32).

2. The decision of the court of appeals is clearly correct and is not in conflict with any other decision. Review by this Court is thus not warranted.

As the court of appeals held, the Commissioner's refusal to order an interference proceeding "was only an interlocutory ruling in the consideration of [petitioners'] application," and "the courts will not consider the problem until there is a final agency decree rejecting [petitioners'] application for patent" (Pet. App. 32–33). Contrary to petitioners' assertion (Pet. 12–14), the administrative appeal provided by the Patent Office Board of Appeals, which petitioners have failed to prosecute, affords them a complete and adequate remedy at law. As the court of appeals concluded, petitioners "may still obtain a ruling from the Patent Office Board of Appeals that their claims are patentable. If their application is finally rejected, they will then be in a position to argue in court that re-

jection was the unlawful product of an improper and arbitrary procedure" (Pet. App. 33).[4]

For the foregoing reasons, the petition for a writ of certiorari should be denied.[5]

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

NOVEMBER 1967.

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[4] The decision of the Patent Office Board of Appeals is reviewable by the Court of Customs and Patent Appeals or by a civil action in the United States District Court for the District of Columbia. 35 U.S.C. 141, 145.

Moreover, 35 U.S.C. 135 provides that "[w]henever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with any unexpired patent," he shall declare an interference. [Italics ours.] Since the Commissioner's determination is thus discretionary in nature, mandamus is not available to coerce the Commissioner to declare an interference. See *Ewing* v. *U.S. ex rel. Fowler Car Co.*, 244 U.S. 1.

[5] While petitioners' failure to obtain a final agency decision is dispositive, we also note the lack of merit in the contention that the Patent Office improperly decided the question of patentability first. The challenged procedure was recently and specifically approved by this Court in *Brenner* v. *Manson*, 383 U.S. 519, 528, fn. 12: "'The question as to patentability of claims to an applicant must be determined before any question of interference arises and claims otherwise unpatentable to an applicant cannot be allowed merely in order to set up an interference.'"

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FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

MEMORANDUM FOR PETITIONERS IN OPPOSITION TO RESPONDENT'S OPPOSING MEMORANDUM

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PREFATORY

The Honorable Solicitor General has inadvertently perpetuated or been led to perpetuate, in his Memorandum for the Commissioner of Patents in Opposition to Doyle *et al.'s* Petition, mistakes and errors both as to the chemistry and the law here involved. Thus, the Solicitor General's conclusion that the Writ of Certiorari should be denied is based on clear errors.

ERRORS OF CHEMISTRY

Phenoxyacetylpenicillanic acid is not known and may not even exist and in any event is definitely not 6-APA. Phenoxyacetylpenicillanic acid, therefore, cannot be a reagent in the production of any penicillin. "6-APA" is 6-aminopenicillanic acid which is an intermediate (the key nucleus) in the production of penicillin V and other penicillins. The Sheehan patent, the claims of which have been copied by Doyle *et al.* in seeking an Interference, do not relate to 6-APA itself, but relate only to the acylation of 6-APA (by the use of an RCO- containing compound) in order to synthesize penicillins therefrom, which penicillins have valuable antibiotic activity. 6-APA has no antibiotic activity. Sheehan did not invent 6-APA. 6-APA is protected by Doyle *et al.* United States Patent No. 3,164,604 which is commonly owned with application Serial No. 826,491 here involved by Beecham Group Limited. These most important facts have been lost sight of both by the Honorable Solicitor General and by the United States Court of Appeals for the District of Columbia Circuit, although the Court was fully advised with regard thereto.

This places the whole situation in a different context and perspective as must be appreciated and the serious errors in chemistry lie at the heart of and exemplify the misconstruction of the issues here involved.

ERRORS OF LAW

The Honorable Solicitor General in his Memorandum for Respondent relies heavily on *Brenner* v. *Manson,* 383 U. S. 519, 528, while failing to realize or recognize that anything contained in said decision, such as in footnote 12 relating to a potential Interference is purely *obiter dicta* because the *Brenner* v. *Manson* case was actually concerned with a very different point; namely, the question of the patentability of a process for producing compounds for which no utility was known or had been proved. This is the real thrust and basis of the *Brenner* v. *Manson* decision. It thus ineluctably follows that *Brenner* v. *Manson* was concerned with utility and proof of utility which is a matter of patent law involving Section 101 of Title 35 of the United States Code and perhaps Section 112, and therefore does not involve Section 135 of Title 35 of the United States Code which is here involved. Any comments by the Supreme Court of the United States to the contrary notwithstanding, the *Brenner* v. *Manson* case did not settle or even consider any of the issues here involved and presented now for this Court's consideration and Judgment in the Petition for Writ of Certiorari.

Insofar as footnote 12 of the *Brenner* v. *Manson* decision, *supra,* refers to the Application of Rogoff (commonly cited as *In re Rogoff,* 46 CCPA 733; 120 USPQ 185) both the Honorable Solicitor General and the United States Court of Appeals for the District of Columbia Circuit have not taken into account or given any weight to the vital fact that the *Rogoff* case involved a reissue question outside the reissue statute because Rogoff was attempting to patent by way of a reissue application claims neither broader nor

narrower than those of his granted patent and hence the Examiner properly rejected such claims. This is no precedent whatever for rejecting claims (found in another's patent as is the case here) on the very patent with which the Interference is sought. This in itself is a far reaching principle without precedent and not heretofore decided.

Factual and legal errors appear on page 2 and in footnote 3 of the Solicitor General's Memorandum for Respondent for the instant case does raise a question with respect to the quantum of proof necessary to institute an Interference because the Examiner has specifically conceded that while Petitioners have made a *prima facie* showing, they have not made a conclusive showing and which latter showing he maintains they must make. This the Solicitor General concedes (his memorandum—near bottom of page 2). This is not in accord with any Interference rule of the United States Patent Office and furthermore, if Doyle *et al.* had to and did present conclusive proof, there would be no point in declaring an Interference because they would have already in effect won the Interference and should not have to re-win it. In addition and because of the existence of Section 104 of Title 35 of the United States Code, Doyle *et al.*, being foreign inventors, are discriminatorily precluded from carrying their date of invention back of their underlying first British application (August 2, 1957) and which date has already been awarded to them. Certainly as a proper alternative, Doyle *et al.* have a right to attack the effective date of the Sheehan patent with which the Interference has been demanded and concededly plausible and reasonable affidavit evidence is already on record by outstanding and even world famous scientists such as Sir Robert Robinson, whose qualifications

and achievements are of record and are of the very highest calibre, including a Nobel Prize, as well as that of John Herbert Charles Nayler, one of the present Petitioners and who is an internationally recognized and outstanding authority in penicillin chemistry. The Patent Examiner, the Commissioner of Patents and the lower courts, have automatically accorded to Sheehan the benefit of his abandoned application filed March 1, 1957 as the effective date of his Patent No. 3,159,617 which issued on December 1, 1964 without permitting Doyle *et al.* any opportunity to contest the awarding of such date and in fact as is known to the Honorable Solicitor General, the Patent Office suspended action on Doyle *et al.'s* case and then without notice or warning of any sort to Doyle *et al.* issued the Sheehan patent and then Finally Rejected on the first action Doyle *et al.'s* application with respect to the Sheehan claims which Doyle *et al.* had on file long before the issuance of the Sheehan patent. This shows the inimical and inequitable attitude of the Patent Office toward Doyle *et al.'s* application, all based upon the fallacious proposition that Sheehan had invented 6-APA when, in fact, he did not and the records unquestionably prove this (see Patent No. 3,164,604 referred to, *supra*). Furthermore, even the penicillin V allegedly produced by Sheehan according to his abandoned March 1, 1957 application (see page 10 thereof) was specified as a racemate and was only obtained in a yield of 10% at most (Sheehan's own affidavit of May 1959) and based thereupon, penicillin never would have become commercially successful as it was Doyle *et al.*, not Sheehan, who made penicillins commercial and available to the public as "wonder drugs". In his abandoned application of March 1, 1957, Sheehan refers to the fact that

the L-isomer was inactive without in any way showing that he made or attempted the difficult optical resolution to obtain the D-isomer which is the only active isomer, it being common knowledge that racemates are made up of approximately 50/50 mixtures of D- and L-isomers and that in almost every instance of a racemate, only one isomer has any chemotherapeutic or biological value and activity and hence the inactive isomer is nothing but ballast or impurity. But even so, a 10% yield of racemate was nothing more than a laboratory curiosity contributing nothing of value or interest to the public or to the treatment of diseases caused by Gram negative and/or Gram positive micro-organisms and hence were matters left as Sheehan had left them, there would have been no contribution to the public and to the treatment of disease since Sheehan at most accomplished an ingenious total synthesis of racemic penicillin V, a matter of great scientific interest as a chemical exercise, but not of any practical or real utility or value otherwise.

Moreover, it will appear from what has preceded that in actuality, Petitioners should be set up as the senior party in the requested Interference and then Sheehan would have to show that he was entitled to his alleged March 1, 1957 date which concededly precedes Doyle *et al.'s* date of August 2, 1957 because of the restrictive nature of 35 USC 104, *supra.* It must also be borne in mind that while 35 USC 135 refers to conception of an invention, such alone is not enough to establish that an invention has been made since questions of reduction to practice, diligence, adequacy of notebook records, testimony of Sheehan, presence or lack of corroboration and many other factors enter into the correct determination of the outcome of an

Interference which is a proceeding set up by the Patent Office to determine which of various claimants is entitled to a patent since under existing United States patent law it is a fundamental principle that only the first inventor is entitled to a patent. Thus, mere conception is not enough and even assuming without admitting that Sheehan had the concept, it is necessary for him to show that he had and made the invention and that he had a prior basis for the claims involved in Doyle *et al.'s* demand for Interference. Petitioners have in fact complied with all the prescribed rules of the Commissioner of Patents, even the newest Interference rules effective July 1, 1965 which have never heretofore been interpreted and hence Petitioners maintain they had every right in asking the Commissioner of Patents to interpret his own newly promulgated rules, a request which the Commissioner refused to act upon even though a properly framed Petition (pursuant to his own rules) was filed asking him to do exactly that. There is thus a very broad underlying principle involved here which the Supreme Court of the United States should consider and pass upon; namely, whether the Commissioner of Patents or the head of any other administrative agency of the United States government can act arbitrarily or refuse to act or otherwise deprive Petitioners of due process of law and the right to obtain the needed and relevant testimony (from Sheehan and from his records) and insulate that action from judicial review. If the Commissioner of Patents can prevent his final action from being judicially reviewed, then likewise the Commissioners or administrative heads of other governmental administrative agencies can and will do the same to the detriment and damage of the rights of those thereby adversely affected. Contrary to the position of the Patent Office and appellate tribunals

so far involved, the issues raised by Petitioners are markedly different from and cannot be decided by the Patent Office Board of Appeals. The scope and interpretation of 5 USC 1009 and 28 USC 1361 are at issue here as well as the Patent Office Interference Rules.

Petitioners are clearly entitled to the review which they seek and they have no other effective remedy. There is no precedent directly in point contrary to Petitioners' position. *Brenner* v. *Manson* and *In re Rogoff*, both cited *supra*, are neither controlling nor dispositive of the issues raised by Doyle *et al.* These issues are exceedingly important and have wide ramifications. They can only be settled by the authority of the Supreme Court of the United States whose decision will bear importantly on public interests of inventors and others.

Respectfully submitted,

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November 29, 1967